

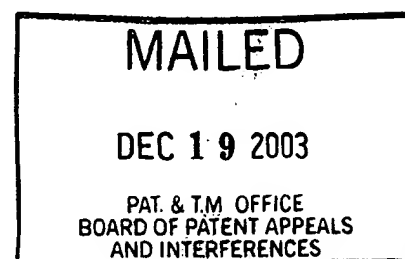
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte WILLIAM S. YERAZUNIS and DARREN L. LEIGH

Appeal No. 2002-0541
Application No. 09/150,360

ON BRIEF



Before THOMAS, DIXON, and BARRY, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

REMAND OF APPEAL

A patent examiner rejected claims 36-40. The appellants appeal therefrom under 35 U.S.C. § 134(a). We remand.

"The review authorized by 35 U.S.C. Section 134 is not a process whereby the examiner . . . invite[s] the [B]oard [of Patent Appeals and Interferences] to examine the application and resolve patentability in the first instance." *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (Bd.Pat.App. & Int. 1999). In an *ex parte* appeal, "the Board is basically a board of review — we review . . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (Bd.Pat.App. & Int. 2001). Here, after

considering the record, we are persuaded that "[t]he appeal is manifestly not ready for a decision on the merits." *Braeken*, 54 USPQ2d at 1112.

"For each rejection under 35 U.S.C. 103, the examiner's answer . . . shall . . . state the ground of rejection and point out where each of the specific limitations recited in the rejected claims is found in the prior art relied upon in the rejection. . . ." M.P.E.P. § 1208. "[W]here there are questions as to how limitations in the claims correspond to features in the prior art . . . , the examiner shall compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison shall align the language of the claim side-by-side with a reference to the specific page, line number, drawing reference number, and quotation from the prior art, as appropriate." *Id.*

Here, the examiner declines to point out where each limitation recited in claims 36-40 is found in the prior art upon which he relies. He also declines to compare any of the rejected claims feature-by-feature with that prior art. In rejecting claims 36-40 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,342,054 ("Chang") and U.S. Patent No. 4,835,621 ("Black"), he merely states, "[t]he grounds for rejection is set forth in prior Office Action, Paper No. 3, ¶3 as applied to claims 1-2 and 16-18." (Examiner's Answer at 3.) The examiner adds, "[t]he reason claims 36-40 were finally

rejected was because the scope of those claims is the same as those of claims 1-2 and 16-18, whose merits have been previously treated." (*Id.*)

We agree with the appellants, however, that "[c]laims 36-40 recite features that do not appear in claims 1-2 . . . and 16-18. . . ." (Appeal Br. at 11.) These features include "audio . . . data," "that later stored data is [sic] recorded over previously stored data," and "a non-volatile memory." Furthermore, claims 1, 2, 16, and 18 recite features that do not appear in claims 36-40. These features include "a weapon," "a target line," "a video recording device," "an area surrounding the target line," "a gun," and "a video camera." The examiner's disparate treatment of claims 1, 2, 16, and 18 *vis-à-vis* claims 36-40, moreover, contravenes his assertion that the scope of the two sets of claims is the "same." (Examiner's Answer at 3.) More specifically, although the latter set of claims is rejected, the former set is allowed. (*Id.* at 2.)

We "decline to substitute speculation as to the rejection for the greater certainty which should come from the [examiner] in a more definite [explanation] of the grounds of rejections." *Gambogi*, 62 USPQ2d at 1212. Instead, we ask the examiner to prepare a substitute examiner's answer comparing each of claims 36-40, feature-by-feature,


with Chang and Black.¹ In particular, a mapping of each of the claimed features to lines in the written description or to elements in the figures of the references is needed for a meaningful review.

CONCLUSION

For the aforementioned reasons, the application is remanded to the examiner for further action not inconsistent with the views expressed herein. Any substitute answer submitted by the examiner should be self-contained with respect to all rejections and arguments. No prior examiner's answer or Office action should be referenced or incorporated therein. Similarly, any supplemental brief submitted by the appellants should be self-contained with respect to all arguments. No prior brief should be referenced or incorporated therein.

Because it is being remanded for further action, the application is a "special" application. M.P.E.P. § 708.01(D). Accordingly, it requires immediate action. Furthermore, the Board should be informed promptly of any action affecting status of the appeal (e.g., abandonment, issue, reopening prosecution).


¹The appeal of the rejection evidences that "there are questions as to how limitations in the claims correspond to features in the prior art. . . ." M.P.E.P. § 1208.


JAMES D. THOMAS)


JOSEPH L. DIXON
Administrative Patent Judge

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